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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,542	10/18/2001	Masami Shirai	P21224	5083
7055	7590	07/26/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,542

Applicant(s)

SHIRAI ET AL.

u

Examiner

Thong Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-23, 25-27 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7, 10, 11, 24 and 28 is/are allowed.
- 6) ☒ Claim(s) 8-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 4/19/2004. It is noted that in the mentioned amendment, applicant has made amendments to the specification and the claims. Regarding to the claims, applicant has canceled claims 1-3, and made amendments to claims 4, 6-11, 18 and 24.

Election/Restrictions

2. The amendment to claim 18 in which applicant has changed the dependent status of claim 18 from claim 18/1 to claim 18/12 has resulted that the claims 18, 19/18 and 27/18 depend upon the non-elected claim 12. Thus, those claims are now withdrawn from further consideration because the device as claimed in the group having claim 12-23, 25-27 and 29 is patentably distinguished from the device as claimed in claims 4-11, 24 and 28.

As a result, the claims 4-11, 24 and 28 are reexamined in this Office action, and claims 12-23, 25-27 and 29 have been withdrawn from further consideration as being directed to non-elected invention(s).

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai et al (U.S. Patent No. 5,668,674) in view of Kimura et al (Japanese reference No. 10-39121) (all of record).

Kanai et al disclose an image finder system having an objective lens system (11), an image erecting prism system (13) and an eyepiece lens system (14). In order to prevent the formation of ghost image, Kanai et al teach the formation of an extension section on the exit surface of the image erecting prism system. See columns 2-4 and figs. 1-7. The only feature missing from the art of Kanai et al is that it does not explicitly teach the extension section acting as a light shielding element for preventing the formation of ghost image is formed on the entrance surface of the image erecting prism system as claimed. However, the use of a light shielding element for preventing the formation of ghost image in an image erecting prism system on the entrance surface and/or the exit surface of the image erecting prism system is suggested to one skilled in the art as can be seen in the finder provided by Kimura et al. In particular, the image erecting prism system as described in columns 7+ and shown in figures 3-4 comprises a light shielding element which is able to form on one entrance surface or the exit surface of the image erecting prism system for preventing the formation of ghost image made by off-axis light. Thus, it would have been obvious to one skilled in

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the art at the time the invention was made to modify the finder provided by Kanai et al by utilizing the teaching, i.e., the formation of light shielding member on the entrance surface of an image erecting prism system, as suggested by Kimura et al for the purpose of providing a light shielding element on the entrance surface of the prism system to improve the ability of correction.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai et al (U.S. Patent No. 5,668,674) in view of Sensui et al (U.S. Patent No. 5,796,517).

Kanai et al disclose an image finder system having an objective lens system (11), an image erecting prism system (13) and an eyepiece lens system (14). In order to prevent the formation of ghost image, Kanai et al teach the formation of an extension section on the exit surface of the image erecting prism system. See columns 2-4 and figs. 1-7. The only feature missing from the art of Kanai et al is that it does not explicitly teach the use of a semitransparent element on the first reflective surface of the image erecting prism system for splitting light to a focus detecting system. However, the use of an image erecting prism system having a semitransparent element formed on the first reflective surface of the prism system for splitting light to a detecting system is suggested to one skilled in the art as can be seen in the finder provided by Sensui et al. In particular, the image erecting prism system as described in columns 6-7 and shown in figures 1 and 3 comprises an image erecting prism system wherein the semitransparent element is formed on the reflective surface of the prism (13) for splitting light to a detecting system (21). Thus, it would have been obvious to one skilled in the art

at the time the invention was made to modify the system provided by Kanai et al by using an image erecting prism system having a semitransparent element formed on the first reflective surface of the prism as suggested by Sensui et al for the purpose of providing light to a focus detecting system.

Allowable Subject Matter

7. Claims 4-7, 10-11, 24 and 28 are allowed over the cited art.

Response to Arguments

8. Applicant's arguments filed on 4/19/2004 have been fully considered but they are not persuasive.

Regarding to the rejection of claim 8 over the combination of art provided by Kanai et al (Patent No. 5,668,674) and Kimura et al (Japanese reference No. 10-39121), applicant's arguments provided in the amendment, pages 17-18, have been fully considered but they are not persuasive for the following reasons.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of an erecting prism system having reflective surfaces which prism system has a similar structure as that disclosed in the present applicant is provided by the primary reference, i.e., Kanai et al, Patent '674. The secondary reference, i.e., Kimura et al, Japanese reference '121, is used in the combination to show that a light shielding mask can be used in either an entrance surface of a prism or an exit surface of a prism. As a result, one skilled in the art will recognize that (s)he can modify the optical device having an objective lens, an eyepiece, an erecting prism system located between the objective lens and the eyepiece which prism has an extension formed on the exit surface as provided by Kanai et al by arranging the extension section in the entrance surface as suggested by Kimura et al for the purpose of shielding light. Regarding to the feature related to the reflection of light as claimed, the formation of the extension section on the entrance surface of an erecting prism system of the combined product provided by Kanai et al and Kimura et al will provide a product which has the same structure of that of the device claimed and thus will inherently have the same result as those of the device claimed.

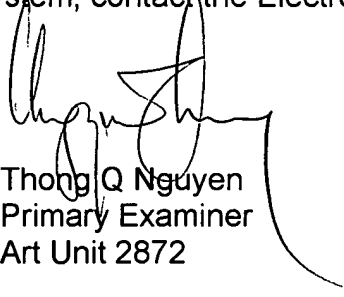
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
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